

Remarks

The Application has been reviewed in light of the Official Action of October 5, 2006. Claims 1 and 14 have been amended. Claims 2-5, 7, 8, and 17-27 have been cancelled. Claims 28 and 29 are new. Claims 1, 6, 9-16, 28 and 29 are currently pending in the Application.

Applicants submit that no new matter is introduced by the amendments because the amendments correspond to matter already in the claims and disclosed in paragraphs [0024], [0025] and [0089] of the specification.

The Examiner rejected claims 1, 2, 7, 9-12 and 14-17 under 35 U.S.C. 102(b) as being anticipated by Tsuyuki et al. (U.S. Pat. 5,547,457). The Examiner rejected claims 1, 2, 6, 7, 9-11 and 13-17 under 35 U.S.C. 102(b) as being anticipated by Miyazaki (U.S. Pat. 6,184,923). The Examiner rejected claim 6 under 35 U.S.C. 103(a) as being unpatentable over Tsuyuki in view of Abramson (U.S. 4,425,375).

Applicants request that the Examiner reconsider the rejections because claim 1 as amended requires "a part of said imaging optics arranged in said shaft is exchangeable in said shaft."

With respect to Tsuyuki, the Examiner states that "any optic element is 'exchangeable' either by replacing the element itself or using a different shaft." (page 4). Similarly with respect to Miyazaki, the Examiner states that "cover glass (not numbered) and imaging device in distal end of shaft which, by inherent nature of being a combination of component parts, are 'exchangeable.'" (page 5). However, Applicants respectfully submit that it is not inherent that the parts in the shafts of either reference are exchangeable. Tsuyuki discloses a single set of dedicated lenses that are incorporated into the shaft. Miyazaki discloses a glass plate installed in front of an electronic imager. The only exchangeable parts are the adapters that house image optics. Neither reference discloses nor fairly suggests that these elements can be removed after the endoscope is assembled. Further, Applicants note that Miyazaki does not disclose image

optics in the shaft. Miyazaki discloses a glass plate in the shaft, which is noted in the specification not to have an optically image effect. (See app. par. [0088]).

Similarly, neither reference discloses that “said part of said imaging optics arranged in said shaft comprise a first imaging part that is exchangeable with a second imaging part; wherein said first imaging part corresponds to a first interchangeable head and said second imaging part corresponds to a second interchangeable head,” as required by dependent claim 28, or that “said part of said imaging optics arranged in said shaft comprise a first imaging part that is exchangeable with a second imaging part and said first imaging part differs from said second imaging part with respect to an optical property,” as required by dependent claim 29.

Based on the foregoing, Applicants respectfully submit that the claimed invention as amended is not anticipated by the cited references.

Applicants also note that an alternative rejection under 35 U.S.C. 103(a) would also be improper because the claimed invention is not obvious over the cited references. In order for the claimed invention to be obvious over the prior art, there must be some suggestion or motivation in the cited references to modify or combine the reference in accordance with the claimed invention. See, MPEP §2143; *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). Further, the prior art references must teach or suggest all of the claim limitations. See MPEP §2143.

As noted above, both references disclose that the only exchangeable optics are those disposed in the adapters. Neither reference discloses exchangeable optics that are disposed in the shaft. The specification to this Application notes that imaging optics in a shaft are exchanged in order to accommodate a different type of interchangeable head. (App. par. [0025]). Neither reference discloses or suggests changing the imaging optics in a shaft to accommodate a different type of interchangeable head. As a result, one skilled in the art would not be motivated to modify or combine the references to provide “a part of said imaging optics arranged in said shaft is exchangeable in said shaft.”

For the same reasons, one skilled in the art would not be motivated to modify or combine the references to provide "said part of said imaging optics arranged in said shaft comprise a first imaging part that is exchangeable with a second imaging part; wherein said first imaging part corresponds to a first interchangeable and said second imaging part corresponds to a second interchangeable head," or "said part of said imaging optics arranged in said shaft comprise a first imaging part that is exchangeable with a second imaging part and said first imaging part differs from said second imaging part with respect to an optical property."

In view of the foregoing amendments and remarks, it is respectfully submitted that all of the claims currently pending in the application are in condition for allowance. Reconsideration and notice to that effect is earnestly requested.

Respectfully submitted,

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